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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : George M. Alleman, Jr. et al
For : ALL-TERRAIN UNDERCARRIAGE
Serial No. : 09/411,106
Filed : October 4, 1999
Group Art Unit : 1725
Examiner : Colleen P. Cooke
Our Docket No. : LEEE 2 12396

SECOND REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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Dear Sir:

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This is a Reply Brief to the Supplemental Examiner's Answer mailed on January 30, 2004.

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The Supplemental Answer by the Examiner was filed in response to the Remand by the Board mailed November 10, 2003. This Reply Brief incorporates by reference the arguments previously set forth in the Appeal Brief filed on December 31, 2001, the Supplement to Appeal Brief filed on March 11, 2002, the Revised Appeal Brief filed on April 25, 2002, and the Reply Brief filed on June 13, 2002.

I. NON-CONTESTED MATTERS

Appellants have noted that the Examiner has again agreed with the statements made concerning the Real Party in Interest, the Related Appeals And Interferences, the ClaimsAppealed, and the Prior Art of Record. The Examiner again did not make any statement concerning the

Summary of the Invention, thus Appellants assume the Examiner agrees with the summary.

II. STATUS OF THE CLAIMS

The Examiner prepared a new statement concerning the Status of the Claims and the Status of Amendments After Final. The Examiner correctly indicated that claim 51 was canceled. The Examiner indicated that the rejection of claims 71-73 and 82 under 35 U.S.C. 112(1) has been withdrawn. The Examiner also indicated that the rejection of claims 29-31 under 35 U.S.C. 112(2) has been withdrawn. The Examiner further indicated that claims 2, 7, 11, 56 and 75 are now indicated as including allowable subject matter. As such, the Examiner stated that if claims 2, 7, 11, 56 and 75 were rewritten in independent form to include all the limitations of the parent claims and any intervening claims and also were rewritten to overcome and rejections under 35 U.S.C. 112, claims 2, 7, 11, 56 and 75 and dependent claims 4,6, 8, 10, 12, 14-15, 17-18, 20-21, 23, 25, 27-28, 30-31 and 72 would be allowable.

The claims that are maintained by the Examiner as being rejected are claims 48-61 and 72-82 under 35 U.S.C. 112(1) and claims 1, 3, 5, 9, 13, 16, 19, 22, 24, 26, 29, 48-50, 52-55, 57-61, 73-74 and 82 under 35 U.S.C. 103(a). The Examiner initially indicated that the rejection of claims 71-73 and 82 under 35 U.S.C. 112(1) was not being maintained; however, in the next sentence the Examiner indicated that the rejection of claims 72-82 under 35 U.S.C. 112(1) was being maintained. As a result, there is a conflict with the Examiner's statement concerning claims 72, 73 and 82. Appellants also note that claims 76-81 do not exist in this appeal, thus cannot be rejected under 35 U.S.C. 112(1). Once again, Appellants are not clear as to which claims remain rejected. For purposes of this Supplemental Reply Brief, it will be assumed that claims 72, 73 and 82 remain rejected under 35 U.S.C. 112(1).

III. THE GROUPING OF CLAIMS

The Examiner again addressed Appellants' grouping of the claims. The Examiner once again asserted a grouping of the claims which is contrary to the grouping of the claims set forth in Appellants' Revised Appeal Brief. The Examiner asserted that only four groups of claims exist in this appeal, namely Group 1 (Claims 1, 5, 9 and 71), Group 2 (Claims 2, 4, 6, 8, 10, 12, 14, 15, 17, 18, 20, 21, 23, 25, 27, 28, 30, 31 and 72), Group 3 (Claims 48, 49, 50, 52, 53, 54, 55, 57 and 73), and Group 4 (Claims 74 and 82). As to the Examiner's Group 1 designation, the 35 U.S.C. 112(1) rejection of claim 71 was withdrawn by the Examiner. As such, claim 71 should not be part of Group 1.

Appellant reasserts the following grouping of claims for this Appeal:

Group 1 - Claims 1, 5, 9, and 22.

Group 2 - Claim 3.

Group 3 - Claim 13.

Group 4 - Claim 16.

Group 5 - Claim 19.

Group 6 - Claim 26.

Group 7 - Claim 29.

Group 8 - Claims 48, 49, 50, 52, 53, 54, 55, 57 and 73.

Group 9 - Claim 58.

Group 10 - Claim 59.

Group 11 - Claim 60.

Group 12 - Claim 61.

Group 13 - Claim 72.

Group 14 - Claims 74 and 82.

Appellants submit that the above grouping of the claims is supported by the briefs of record.

IV. THE NON-ENTRY OF PROPOSED AMENDMENT FOR APPEAL

The Examiner stated that issue relating to the non-entry of the Proposed Amendment for Appeal relates to a petitionable matter, thus is not appealable. As previously stated, the amendment was filed pursuant to 37 C.F.R. §1.116 which constituted mere formal corrections to the claims. The proposed amendments to claims 1, 9, 10, 15, 48-50, 52-55, 57-59, 73-75 and 82 merely corrected several grammatical errors in the claims and/or corrected several antecedent basis problems in the claims that were not identified by the Examiner or Appellants prior to the filing of the Notice of Appeal. The refusal by the Examiner to enter the amendment will result in Appellant having to wait for the appeal to be completed and to then expend additional resources to prepare and file a certificate of correction for any of these claims that ultimately issue. Appellants once again submit that the Examiner has abused his discretion in rejecting the Amendment for Appeal.

V. EXAMINER'S ARGUMENTS

A. The Rejection Under 35 U.S.C. 112(1)

The Examiner maintained the rejection of claims 48-61, 73-75 and 82 under 35 U.S.C. §112, first paragraph, for including the term "axes." Appellants maintain that the rejection of these claims is in error and should be withdrawn. Appellants' arguments concerning this issue are incorporated herein from the previously filed briefs. The Examiner has not provided any evidence which rebuts Appellants evidence of record that the term "axes" was included in the original Specification, thus supports use of the same term in the pending claims. Indeed, Appellants are at a loss as to the basis of the Examiner's rejection concerning this issue.

B. The Rejection Under 35 U.S.C. 103(a)

The Examiner again asserted that Figure 1 in Karpoff was not relied upon to teach specific dimensions, proportions or measurement, but instead a "rather broad and general relation between parts of an undercarriage ...". Appellants submit that the Examiner's is indeed relying on specific dimensions, proportions or measurement in Karpoff to support a rejection of the claims. The Examiner crafted a modified illustration of Figure 1 of Karpoff in the Office Action dated October 18, 2001 which attempted to establish that the limitation of Appellants' claims was taught by Karpoff. Indeed, the Examiner is still providing spacing measurements in the past and present Answer. If the Examiner is not relying on Karpoff to teach specific dimensions, proportions or measurement, it is then unclear why the Examiner is rejecting the claims.

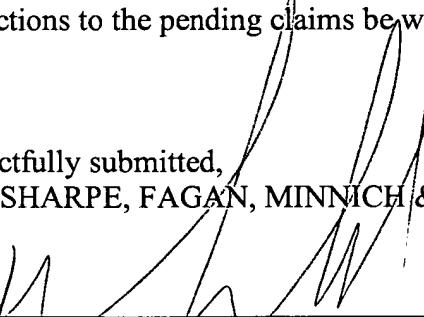
Appellants' arguments concerning the rejection of the claims under 35 U.S.C. 103(a) are incorporated herein from the previously filed briefs.

VI. SUMMARY AND CONCLUSION

Appellants again assert that the prior art references of Karpoff, Sueshige, Magda, and/or Momberg do not disclose, teach or suggest the undercarriage defined in the pending claims.

Appellants respectfully request that the rejections to the pending claims be withdrawn and the claims be indicated as allowable.

Respectfully submitted,
FAY, SHARPE, FAGAN, MINNICH & MCKEE

By: 

ROBERT V. VICKERS

Reg. No. 19,504

1100 Superior Avenue, Seventh Floor
Cleveland, Ohio 44114-2579

Telephone: (216) 861-5582
Facsimile: (216) 241-1666